

REMARKS

Applicants express appreciation for the attention accorded the present Application in the March 12, 2004, Office Action. In the March 12, 2004, Office Action, Claims 1-23 were pending for consideration. Each of these claims was rejected under one or more statutory grounds. Accordingly, reconsideration of all claims in light of the following remarks is respectfully requested.

Claim Rejections - 35 U.S.C. § 102

Before discussing the above rejections, it is thought proper to briefly state what is required to sustain such rejections. It is well settled that “[a] claim is anticipated only if each and every element as set forth in the Claims is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil of California, 814 F.2d 628, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. § 102, all elements of the claim must be found in a single reference. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in W.L. Gore & Assoc., Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), cert denied, 469 U.S. 851 (1984), “anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference.” “The identical invention must be shown in as complete detail as is contained in the...claim.” Richardson v. Suzuki Motor Co. 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim Rejections - 35 U.S.C. § 102(a)

Claims 1, 2, 5-8, 11, 13-16, 21 and 22 were rejected under § 102(a), as being anticipated by Applicants’ Admission. Specifically, Applicants’ Admission describes a method of sampling a given area for zinc particulates. The “wet wipe” swatch is wiped across the given area to gather particulates. The wipe can then be sealed in a plastic bag and sent to a lab where tests are conducted to determine whether zinc is in the form of a zinc whisker. However, with this method, the lab is not always able to determine if the zinc is in the form of a zinc whisker, the

length of the zinc whisker if present, the surface properties of the zinc whisker, or the concentration of zinc whiskers sampled in the given area.

Applicants respectfully submits Claims 1, 2, 5-8, 11, 13-16, 21 and 22 are not anticipated by Applicants' admission. Claims 1, 2, 5-8, 11, 13-16, 21 and 22 are drawn towards a method capable of capturing and retaining the whisker-like metallic particulates in their fragile condition. Applicants submit that a wet wipe or swatch is unable to retain whisker-like metallic particulates in their fragile condition.

As to Claims 1, 11, 13, 15, 16, and 21, Examiner suggests that suspect areas being sampled are located as claimed. Applicants submit that admission does not teach a method capable of capturing and retaining the whisker-like metallic particulates in their fragile condition from a sample area. Thus, the present invention is not anticipated by Applicants' admission.

As to Claims 2, 15, 16, and 21, Examiner submits that the particulates being sampled adhere to the wet wipe. Applicants submits that specification clearly suggests "Adhesive" shall include any material that provides more adhesive strength than the adhesion provided by water on a cloth or paper material (such as with a wet wipe), and are preferably substantially more adhesive. Therefore, a wet wipe and/or swatch is not encompassed within the scope of the present invention.

As to Claim 5, as stated above, a swatch is not covered within the scope of the present invention. Furthermore, Applicants' admission does not teach of a device that is capable of capturing and retaining whisker-like metallic particulates in their fragile condition. A swatch is rubbed along the surface, thus it is inherent that the swatch can not retain the whisker-like metallic particulates in their fragile condition as claimed in the present invention.

As to Claim 6, Examiner submits that Applicants' admission describes sampling from "a given area" to determine "the concentration" of particulates, suggestive of determination of density. The admission does not teach a device that is able to capture or retain a concentration of whisker-like metallic particulates in their fragile condition.

As to Claim 8, Examiner submits admission teaches of a "plastic bag" to protect sample from contamination. The admission does not disclose a method that can retain and protect whisker-like metallic particulates in their fragile condition from substantial contamination.

As to Claim 14, Examiner submits potential sample areas include the bottom of floor tiles, as they are “dragged across the top of each other”, necessarily causing particulates on bottom surfaces. The admission does not suggest extracting from the bottom surface any whisker-like metallic particulates present in substantially their fragile condition. In addition, the step “dragging across the top of each other”, is unable to retain the particulates in their fragile like condition.

As to Claim 22, Examiner suggests that identification is carried out by “visual inspection” in addition to the “wiping”. Claim 22 does not specifically claim a visual inspection to characterize the whisker-like metallic particulates. The invention according to Claim 22 can be carried out by many different methods, such as, electron microscope or other microscopic viewing devices.

In view of above, Applicants’ admission does not disclose each and every element of the claimed invention. Applicants submit that the rejection has been overcome. Therefore, the Applicants respectfully requests that the rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. “The PTO has the burden under § 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To satisfy this burden, the PTO must meet the criteria set out in M.P.E.P § 706.02(j):

... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Moreover, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

The following discussion of the cited references is currently focused on the lack of motivation to combine the cited references. Therefore, the following discussion of applicable case law is considered an important background for the Examiner to keep in mind during this discussion.

In order to maintain a *prima facie* case of obviousness by combining references, the prior art must provide some reason or motivation to make the claimed compositions. *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990). As aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992):

"Before the PTO may combine the disclosure of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art... Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the...art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed (invention)."

An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich et al.*, 220 U.S.P.Q. 504, 509-511 (CCPA 1979). There the court states that a reference must not be considered in a vacuum, but against the background of the other references of record. It is stated that the question of a § 103 case is what the reference(s) would "collectively suggest" to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

"Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the

art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or any suggestion leading to their combination in the manner claimed by Applicants." (underlining added)

It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning lead the court, in Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

"...it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." (underlining added)

In re Sernaker, 217 U.S.P.Q. 1, 5-6, (Fed. Cir. 1983) states a test to determine whether a rejection of an invention based on a combination of prior art elements is appropriate as follows:

"The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings...The board never showed how the teaching of the prior art could be combined to make the invention." (underlining added)

Moreover, in In re Dow Chemical Co., 5 U.S.P.Q.2d 1529, (Fed. Cir. 1988), the court states that both the suggestion and the expectation of success must be founded in the prior art, not in the applicants disclosure. The Federal Circuit stated in In re Carroll, 202 U.S.P.Q. 571, 572 (Fed. Cir. 1979):

One of the more difficult aspects of resolving questions of non-obviousness is the necessity "to guard against slipping into use of hindsight (citing Graham v. Deere). Many inventions may seem obvious to everyone after they have been made... (citation of § 103)... Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

Claim Rejections - 35 U.S.C. § 103(a)

With the above background in mind, Applicants contends that the Examiner has failed to meet the burden of making a *prima facie* case of obviousness.

Claims 7 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement. Because Claims 7 and 12 are dependent on allowable claims, Applicants respectfully submits that such rejection is moot and respectfully requests that the rejection be withdrawn.

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement as applied to claim 1 above, and further in view of Jezek.

Jezek teaches a sampling device to sample radioactive waste where the sample is collected and the pad and body are enclosed in a cap. The cap is designed to totally enclose and retain the pad and body of the sampling device. The reference does not teach protecting whisker-like metallic particulates sample in their fragile condition from further contamination or storing whisker-like metallic particulates sample in their fragile condition such that the adhesive portion does not contact the enclosure.

Jezek does not teach or suggest that the sampling device can be used for capturing or retaining whisker-like metallic particulates in their fragile condition. Therefore, it would not be obvious to one of ordinary skill in the art, to modify the reference or to combine the reference teachings.

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement as applied to claim 15 above, and further in view of Johnsson et al. Because Claim 23 is dependent on allowable claims, Applicants respectfully submits that such rejection is moot and respectfully requests that the rejection be withdrawn.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement as applied to claim 2 above, and further in view of Moos. Because Claim 10 is dependent on allowable claims, Applicants respectfully submits that such rejection is moot and respectfully requests that the rejection be withdrawn.

Claims 1-23 were rejected under the judicially created doctrine of double patenting over corresponding claims 1-14, 16-19, and 22 of U.S. Patent No. 6,651,521. Applicants respectfully

submit the enclosed terminal disclaimer to overcome the judicially created doctrine of double patenting rejection.

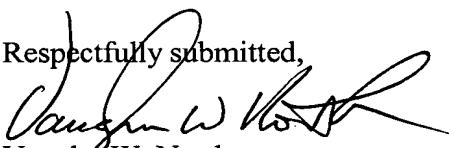
Applicants now submit that claims 1-23 are allowable and respectfully requests that all rejections be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe that the present patent application is in condition for allowance and allowance thereof is respectfully requested. Therefore, Applicants request that the rejections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Vaughn North at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 9th day of June, 2004.

Respectfully submitted,

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